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IN THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION
IN ITS COMMERCIAL DIVISION

INTERIM APPLICATION NO.490 OF 2023
IN
COM IP SUIT NO.16 OF 2023
WITH
COURT RECEIVER'S REPORT NO.69 OF 2023
WITH
LEAVE PETITION (L) NO.40501 OF 2022

Elektromag Devices and Ors.

...Applicants /
Plaintiffs

Versus

Nikhil Ravindra Bhawalkar & Ors.

...Defendants

Rashmin Khandekar with Mr. Ashutosh Kane and Ms. Maitri Asher i/
b. W.S. Kane & Co. for the Plaintiffs.

Alankar Kirpekar, Shekhar Bhagat, Ayush Tiwari, Rajas Panandikar
and Chinmay Pagedar i/b Shekhar Bhagat and Neelaja Kirpekar for
Defendants.

Mrs. Rekha Rane, 2nd Assistant to Court Receiver.

CORAM : R.I. CHAGLA J.
DATE : 20 JUNE 2023.

ORDER :

1. The learned Counsel for the parties have consented to
the final disposal of the Interim Application (L) No.490 of 2023.
There was an exparte ad-interim order dated 16th January, 2023
passed by this Court, wherein this Court had found that a strong

prima facie case had been made on behalf of the Plaintiffs for grant of ad-interim relief. Accordingly, ex parte ad-interim relief in terms of prayer Clauses (a) and (b) was granted. The Court Receiver appointed by this Court has through additional Special Receiver executed the commission and filed Court Receiver's Report No. 69 of 2023 dated 22nd February, 2023 which has been taken on record.

2. In view of the Defendants having been served during the execution of the commission, the Leave Petition filed under Clause XIV of the Letters Patent Act is made absolute in terms of prayer Clause (a). The cause of action of passing off is joined with infringement.

3. Mr. Kirpekar learned Counsel for the Defendants commenced arguments seeking vacation of the said ex parte ad-interim order, on the ground that the Defendants did not get a chance to demonstrate the correct law and facts which are now being placed for determination.

4. In the ex parte ad-interim order dated 16th January, 2023, this Court had considered that the 1st Plaintiff is in the

business of manufacturing and trading in inter-alia electrical equipment and apparatuses using electromagnets including lifting magnets, magnet separators, metal detectors, vibrating furnace charger, vibrating feeders, cable and hose handling equipment, construction equipment and the like goods (“the said goods”).

5. The 2nd and 3rd Plaintiffs are companies incorporated under the Companies Act who are the licensed / permanent users of the 1st Plaintiff with respect to the Suit Trade Marks. They carry on business of manufacturing and marketing the said goods for and on behalf of the 1st Plaintiff.

6. The Plaintiff had applied for and obtained registration of their trademark ELEKTROMAG and registered device . The registration of the marks have been granted in favour of the 1st Plaintiff on or about 23rd December, 1980. The marks of the Plaintiff which have been registered are as under:-

Sr. No.	Trade Mark	Reg. No.	Class	Goods
1	ELEKTROMAG	370060	09	Electrical equipments using

				permanent and electro magnets
2		370061	09	Magnetically operated electrical apparatus

The aforementioned registration are valid subsisting.

7. The Defendant No.1 was an ex-employee of the 2nd Plaintiff and claims to be a Director of the 2nd Defendant which in turn claims to be a group entity of the 3rd Defendant. The 4th Defendant is a partner of the 3rd Defendant and also claims to be the CEO of the 3rd Defendant.

8. The 1st Defendant had worked with the Plaintiffs during two periods of time, first between 2011 and 2013 and second from 2014 till 2021, in the marketing division.

9. The Plaintiffs have relied upon Trade Mark Registration Certificates to show that the registration of the word mark

ELEKROMAG and device  dates back to 1980, with user since September, 1973. The Plaintiffs have also placed on record

copies of invoices dating back to 1982 to emphasize the presence of the Plaintiffs in the market for a long period of time. The Plaintiffs have further referred to the Sales Turnover in paragraph 7 of the Complaint. The annual sales turnover of the 2nd and the 3rd Plaintiffs between the years 2012-13 and 2021-22 are as under:-

Sr. No.	Financial Year	2nd Plaintiff	3rd Plaintiff
1	2012-13	519426296	340038091
2	2013-14	450906433	279153517
3	2014-15	504871910	332428072
4	2015-16	435783881	339860431
5	2016-17	425096092	354179152
6	2017-18	464522069	340338055
7	2018-19	651428536	423230763
8	2019-20	588115698	405087148
9	2020-21	546703569	323824794
10	2021-22	770056761	486147283

10. The Plaintiffs have relied upon the certificates from the Chartered Accountant certifying the correctness of the annual sales turnover figures. The copies of specimen invoices showing sale of the said goods bearing the aforementioned Trade Marks / under the said trading names and styles are at Exhibits “B-1”

to “B-30” of the Plaint. The Plaintiffs have also annexed at Exhibits “C-1” to “C-17” the specimen advertisement materials being pamphlets, brochures, etc showing advertisement and promotion of the said goods bearing the aforementioned Trade Marks of the said business under the said trading names and styles. The Plaintiffs have also annexed at Exhibits “D-1” to “D-4” colour photographs of the Plaintiffs’ goods bearing the Trade Mark “ELEKTROMAG” which appears prominently on the goods originating from the Plaintiffs.

11. The Plaintiffs also claim that due to the long, continuous and extensive use of the aforementioned Trade Marks and the said trading names and style, they have become popular and well-known amongst the consumers as also business circles and traders not just in India but in over 50 countries across the globe. It is their contention that the increasing annual turnover of the Plaintiffs is a telling testimony of the popularity of the Plaintiffs, their said Trade Marks and trading names and styles and their said goods. It is their contention that the aforementioned Trade Marks and Trade names and styles have acquired wide and enviable goodwill and reputation amongst the members of the trade and consumers. Further, the Plaintiffs said Trade Marks and trading names and styles

have also acquired factual distinctiveness as well as a secondary meaning as connoting and denoting to the members of trade and public, the said goods and business of the Plaintiffs' origin and of none else.

12. The Plaintiffs have also stated that on or before 24th August, 1998, they registered the top level domain name 'elektromag.com' with a view to do business through the internet and to facilitate communication. The printout of "ICANN WHOIS" database showing registration of the aforesaid domain name is annexed to the Complaint at Exhibit E. The Plaintiffs have also contended that they have done substantial business through the internet. The said domain name is also exclusively associated with the 1st Plaintiff.

13. The Plaintiffs have stated that in March, 2022, the Defendant No.1 reached out to Mr. Gulu Advani, one of the partners of the 1st Plaintiff via Whatsapp informing Mr. Advani that he has started magnet manufacturing in Ahmedabad and that Mr. Advani is his inspiration for the same.

14. The Plaintiffs claim that when they participated in

an Inter Foundry International Exhibition and Conference for Ferrous and Non-Ferrous Foundry Industry held at Coimbatore in September, 2022, they came across the booth of Defendant No.3 and through the same, for the first time came to know that the 2nd Defendant is manufacturing and trading in the impugned goods under the Trade Mark ELEKTRO Magnetisch as also under a composite Trade Mark



along with the trading name and style “ELEKTRO

Magnetisch” and EM ELECKTRO Magnetisch



(“the impugned trading names and styles).

15. The Plaintiffs have also stated that they were surprised to find that the Defendants were operating a website / domain name www.elektromagnetisch.com which was similar to the domain name of the Plaintiffs www.elektromag.com which was granted in the year 1998. The Plaintiffs have further stated that when they confronted the Defendants about use of the impugned infringing Trade Mark, the Defendants assured the Plaintiffs that they will stop using the same. It is the case of the Plaintiffs that despite such

assurances being given by the Defendants they are continuously using the impugned / infringing Trade Mark, necessitating filing of the present Suit and application for interim reliefs.

16. The Plaintiffs also claim to have learnt on or about 27th April, 2022 that an application had been made by Defendant

No.4 for grant of registration of the Trade Mark  under Application No.5425037 in class 07 as Device Mark. It is significant to note that the Application was filed on proposed to be used basis.

17. The Plaintiffs have claimed that the Defendant No.1 as an ex-employee could not claim ignorance of the registered Trade Mark of the Plaintiffs and therefore, it is evident that the Defendants have been illegally using the deceptively similar Trade Mark for similar goods.

18. This Court in the exparte ad-interim order dated 16th January, 2023 had considered the material on record as well as comparison of the aforementioned registered Trade Mark and Device

Mark of the Plaintiffs with impugned Trade Mark EM and ELEKTRO Magnetisch of the Defendants and came to a prima facie view that this indicates that the impugned Trade Mark is deceptively similar to the registered Trade Mark of the Plaintiffs. It was noted by this Court that although the Defendants applied for registration under Class 7, while the Trade Marks of the Plaintiff are registered under Class 9, this Court finds that from the brochure of the Defendants the products of the Defendants prima facie appear to be similar to the products of the Plaintiffs sold with the registered Trade Mark of the Plaintiff. Accordingly, this Court held that a strong prima facie case had indeed been made out by the Plaintiffs for grant of ad-interim reliefs.

19. Further, prima facie finding was arrived at that the impugned product is not only phonetically similar but also structurally similar for the reason that the alphabet 'K' is specifically used in the word 'ELEKTRO' which is integral part of the registered Trade Mark of the Plaintiffs. This Court considered that the balance of convenience is in favour of the Plaintiffs and that they are likely to suffer grave and irreparable loss, if ad-interim relief is not granted. The ad-interim relief was granted in terms of the prayer Clause (a)

and (b) of the Interim Application.

20. In this background it would be necessary to consider the application of the Defendants which seeks the vacation of the said exparte ad-interim order dated 16th January, 2023.

21. Mr. Kirpekar the learned Counsel appearing for the Defendants has submitted that the Plaintiff is not entitled to claim exclusivity over the name of the technology i.e. “ELEKTROMAGNETISCH” and / or “ELECTROMAGNETISM” and is not entitled to relief of injunction against the Defendants from using the device or composite mark.

22. Mr. Kirpekar has submitted that there is no visual, structural and phonetic similarity between the rival marks of the Plaintiff and the Defendants. He has submitted that the common feature of the rival words “ELEKTROMAG” and “ELEKTROMAGNETISCH” is due to the fact that, Plaintiff has adopted and used the part of the name of the technology “ELEKTROMAGNETISCH” while Defendant has adopted the entire name of the technology and represented the same in a distinctive

manner by having the word “ELEKTRO” represented in one line and “MAGNETISCH” represented in a separate line.

23. Mr. Kirpekar has submitted that the Defendants’ adoption of the device comprising of the word “ELEKTROMAGNETISCH” is in accordance with the honest and bonafide trade practices. Defendants have used the word “ELEKTROMAGNETISCH” as part of the firm’s name which is engaged in the business of manufacturing and marketing of products comprising of “electrical magnet” and working on the principles of “ELECTROMAGNETISM” is to designate to the trade and consumers that the Defendant is engaged in the business of the said products.

24. Mr. Kirpekar has submitted that it is specific case of the Defendants that “ELEKTROMAGNETISCH” is the name of the technology which literally means “ELECTROMAGNETISM”. He has submitted that the marks of the Plaintiffs’ “ELECTROMAG” is a word derived from “ELECTROMAGNETISM”. The development of the technology of “ELECTROMAGNETISM” was started in Denmark and Germany.

25. Mr. Kirpekar has submitted that there has been a specific reference to the technology titled as “ELECTROMAGNETISM” in Chapter 13, Class 10 CBSE titled as “Magnetic Effects of Electric Current”. The Plaintiff has taken part of the technology name “ELECTROMAGNETISM” i.e. “ELECTROMAG” and started selling the goods based on this technology. Thus, the Plaintiff is not entitled to stop others from using the word “ELECTROMAGNETISM” or any part thereof in respect of the goods working on the principles based on “ELECTROMAGNETISM”.

26. Mr. Kirpekar has submitted that the word “ELEKTROMAG” with alphabet “K” is derived from the old famous book named “Das eleKtromagnetische Feld”. The book was published in the year 1927 which is around 60 years prior to the first date of adoption claimed by the Plaintiff, i.e. in the year 1973. This is a world famous book and all those who are associated with the field of electromagnetisim are fully aware about this book.

27. Mr. Kirpekar has submitted that the Plaintiff cannot claim monopoly over the part of the technology name “elektromagnetische”. Mr. Kirpekar has further submitted that the

google search for the word “ELEKTROMAGNETISCH” shows that it means “ELECTROMAGNETISIM”. Further, upon Trade Mark search it reveals that there are multiple entities engaged in the business of manufacturing and marketing electrical appliances on the basis of “ELECTROMAGNETISIM” technology and all of them are using “K” instead of “C” for the simple reason that, the original word of the technology is in German language and admittedly the said word is “ELEKTROMAGNETISCH”.

28. Mr. Kirpekar has relied upon the law laid down by the Supreme Court in *J.R. Kapoor Vs. Micronix India*¹ in support of his submission that no person or entity is entitled to claim exclusivity over the name or part of the name of a technology, by registering the same under the Trade Marks Act. He has submitted that the Supreme Court in the said decision has in the context of micro technology held that, micro-chip technology being the base of many of the products, the word 'micro' has much relevance in describing the products. Further, the word 'micro' being descriptive of the micro technology used for production of many electronic goods which daily come to the market, no one can claim monopoly over

¹1994 Supp (3) SCC 215.

the use of the said word. Anyone producing any product with the use of micro chip technology would be justified in using the said word as a prefix to his trade name. He has submitted that in the present case also the rival marks are based on the name of the technology and all those who are dealing in the technology of electric magnet are aware about the descriptive usage of the said word “ELEKTROMAGNETISM” or “ELEKTROMAGNETISCH” by the traders as a part of the trading name or any part thereof.

29. Mr. Kirpekar has also relied upon the decision of the Division Bench in the case of *Shelke Bevarages Private Ltd. Vs. Rasiklal Manikchand Dhariwal*², wherein the Division Bench of this Court had relied upon the decision of the Supreme Court in *J.R. Kapoor (Supra)* and another judgment of this Court in *Medley Pharmaceuticals Ltd. Vs. Khandelwal Laboratories Ltd.*³ and held in the said decision that by obtaining the Trade Mark in the name of “MANIKCHAND OXYRICH” the word “OXY” cannot be claimed as exclusively belonging to the Plaintiffs. The word “OXY” or “OXYGEN” is used frequently without any reference to the Plaintiffs. The

²2011 (45) PTC 241 (Bom).

³2006(1) Bom C.R.292.

Plaintiffs cannot claim monopoly of such generic term. This Court held that it cannot be readily inferred that use of word like “OXY” by a rival in the business as part of his trade name would be likely to deceive or create confusion. The Defendants are entitled to claim benefit of even small variations in their Trade Mark from that of the Plaintiffs’ Trade Mark to plead that there would be neither confusion in the mind of prospective buyers nor deception, as claimed.

30. Mr. Kirpekar has accordingly submitted that there is no case made out by the Plaintiffs for grant of ad-interim / interim relief and that the Plaintiffs by seeking such relief is claiming monopoly on the entire name of the technology “ELECTROMAGNETISCH” or “ELEKTROMAGNETISM”. The purpose of the Trade Marks Act is not to grant any monopoly but, to protect the Trade Mark or Trade source. At best, by virtue of Registration of the device mark ELEKTROMAG, the Plaintiff is entitled to seek protection against the use of the identical or deceptively similar word “ELECTROMAG” but certainly cannot claim the monopoly over the entire name of the technology i.e. “ELEKTROMAGNETISCH” or “ELECTROMAGNETISM”. Accordingly, the application made on behalf of the Defendants for vacation of the exparte ad-interim order

be granted.

31. Mr. Khandekar learned Counsel appearing for the Plaintiffs has submitted that there is no case made out for vacation of the *ex parte ad-interim* order granted in favour of the Plaintiffs. Further, the Defendants have made an oral application under Order 39 Rule 4 of the Code of Civil Procedure, 1908 for vacation of the *ex parte ad-interim* order without showing that the Plaintiffs have either made a false or misleading statement in relation to a material particular.

32. Mr. Khandekar has submitted that the impugned trade mark of the Defendants is identical and / or deceptively similar to the Plaintiffs registered Trade Marks. The impugned Trade Mark incorporates the essential and prominent features of the Plaintiffs Trade Mark. He has submitted that the Plaintiffs are having valid and subsisting registration without any condition or limitation with regard to the use of the “ELEKTROMAG” and “EM” (the only disclaimer in the EM registration for device of lighting) and hence, at the interlocutory stage the Court is bound to enforce the registration. He has submitted that the Full Bench of this Court in *Lupin Ltd. &*

Anr. Vs. Johnson & Johnson & Anr.⁴ has laid down the principles for challenge to registration of a Trade Mark. There is an extremely narrow window for challenge to registration, i.e. only if the registration is ex-facie illegal, fraudulent or such as would shock the conscience of the Court. Thus, there is a strong presumption in favour of the Plaintiffs' registrations at the interlocutory stage.

33. Mr. Khandekar has submitted that once the mark is registered, unless it falls in the exceptions carved out by the Full Bench, the mark is presumed to be distinctive. This has been held by this Court in **Lupin Ltd. Vs. Eris Lifesciences Pvt. Ltd. & Ors.**⁵ at paragraph 19 and in **Sapat International Pvt. Ltd. Vs. Girnar Food and Beverages Pvt. Ltd.**⁶. He has also relied upon the decision of this Court in **Pidilite Industries Ltd. Vs. Chiripal Industries Ltd.**⁷.

34. Mr. Khandekar has submitted that once it is clear that the mark is distinctive, the examination required to be conducted by the Court is of the structural, visual and phonetic

⁴2015 (61) PTC 1 (Bom) (FB)

⁵2016(67) PTC 144 (Bom)

⁶NMCD No.1059 of 2015 in Suit No.568 of 2015 dated 6th January, 2016.

⁷Interim Application (L) NO.12828 of 2021 in Coms IP Suit NO.452 of 2021 dated 9th March, 2023.

similarity between the rival marks. He has submitted that this exercise has been carried out by the learned Single Judge of this Court as reflected in the ex parte ad-interim order dated 16th January, 2023 at Paragraphs 7 and 8. Further, the learned Single Judge in the said ex parte ad-interim order had considered that the Defendant No.1 was an ex-employee of the second Plaintiff and was aware of the goodwill and reputation of the Plaintiffs' mark and that the impugned mark is identical with and / or deceptively similar to the Plaintiffs' aforementioned registered Trade Marks as it incorporates the essential prominent features, "ELEKTROMAG" and "EM". In addition to this finding, the learned Single Judge has also considered that the Defendants have also used the alphabet 'K' in the word "ELEKTROMAGNETISCH" making it clear that an attempt is made to piggy back upon the goodwill and reputation of the Plaintiffs' trade mark.

35. Mr. Kirpekar has submitted that the manner in which the Defendants have used the trade mark shows that the essential and prominent features of the Plaintiffs' trade mark is highlighted. It is trite that if the whole of the Plaintiffs' mark is subsumed in the Defendants' mark, a case for infringement is made

out. He has in this context relied upon the decision of this Court in *Jagdish Gopal Kamath & Ors. Vs. Lime & Chilli Hospitality Services*⁸.

36. Mr. Khandekar has submitted that in view of the Defendants themselves applying for registration of a trade mark containing “ELEKTROMAGNETISCH” as its leading and essential feature, are estopped from claiming that either the Plaintiffs’ Trade Mark “ELEKTROMAG” or the Defendants’ impugned trade mark “ELEKTROMAGNETISH” is descriptive / common to the trade and that no monopoly or exclusivity can be claimed therein. He has in this context relied upon the decisions of this Court in *Lupin Ltd. Vs. Eric Lifesciences Pvt. Ltd. & Ors. (Supra)*, *Jagdish Gopal Kamath (Supra)* and *Pidilite Industries Ltd. Vs. Chirpal Industries Ltd.*⁹

37. Mr. Khandekar has submitted that whilst denying that the Plaintiffs’ trade mark is generic, due to the long, substantive and extensive use of the said trade mark, it has acquired distinctiveness and a secondary meaning and it connotes and denotes to the members of the trade and public, the goods of the Plaintiffs’

82015(62) PTC 23 (Bom)

9 Interim Application (L) No.12828 of 2021 in Coms IP Suit No.452 of 2022 dated 9th March, 2023.

origin and of none else. He has in this context relied upon *Sky Enterprises Pvt. Ltd. Vs. Abaad Masala & Co.*¹⁰ and *Jagdish Kamath (Supra)* and *Pidilite Industries Ltd (Supra)*.

38. Mr. Khandekar has submitted that the Defendants own conduct shows that they have always been using “ELEKTROMAGNETISH” in the sense of a mark and not as a descriptor. He has relied upon the description of the Defendants mark on their goods in photographs at Exhibits H-1 at Page 153 and 158 and Exhibit I at pages 166 and 167 of the Plaint.

39. Mr. Khandekar has submitted that the Defendants’ claim that the using of “ELEKTGROMAGNETISCH” merely as a descriptor and not as a trade mark, is false. The consumers, trade and public will refer to and know the Defendants’ mark as “ELEKTROMAGNETISCH” and not from the label that is applied for. The Defendants have clearly used “TM” in respect of their trade mark, thereby asserting a monopoly of the use of their Trade Mark. It is, therefore, not open for the Defendants to contend that “ELEKTROMAGNETISCH” is merely a descriptor or to seek benefit of

¹⁰(2020) 81 PTC 569.

Sections 30(2) or 35 of the Trade Marks Act, 1999. The provisions do not protect use of the mark but are in relation to the non trade mark like usage as set out in the said provisions.

40. Mr. Khandekar has submitted that the reliance by the Defendants on the fact that “ELEKTROMAGNETISCH” means Electromagnetism in German is absolutely irrelevant in the facts of this case. He has submitted that it is settled law that a word of a foreign language cannot be extrapolated and applied in the Indian context to presume that the general public would be aware of the meaning of such a word. The Defendants cannot presume knowledge of the Indian public words which have foreign origins and meanings. He has in this context relied upon the decision of this Court in *Kamini Oil Industries Pvt. Ltd. Vs. Bhuwaneshwar Refineries Pvt. Ltd.*¹¹ at Paragraph 23 and *Aktiebolaget Volvo of Sweden V. Volvo Steels Ltd. of Gujarat (India)*¹² at paragraphs 51, 52 & 53.

41. Mr Khandekar has also distinguished the decision of the Supreme court in *J.R Kapoor (Supra)* and *Shelke Beverages (Supra)*. He has submitted that in the facts of those cases, the marks

¹¹2014(59) PTC 310 Bom.

¹²(1998) 18 PTC 47 DB (Bom).

have been compared as a whole and upon which the Court came to a conclusion that the rival Trade Marks were neither identical nor deceptively similar to one another, unlike in the present case, where upon evaluation of the rival marks, the learned Single Judge in the exparte ad-interim order arrived at a finding that the rival trade marks are identical with / deceptively similar with one and another and that Defendants have copied the Plaintiff's trade mark. Mr. Khandekar has placed reliance upon the decision of this Court in *Natco Pharma Limited and Anr. Vs. Merck KGaA and Anr.*¹³ which referred to the decisions of Supreme Court in *J.R. Kapoor (Supra)* and *Shelke Beverages Pvt. Ltd. (Supra)* and despite of which granted injunction because on an overall comparison of the rival Trade Marks, this Court found them to be deceptively similar.

42. Mr. Khandekar has accordingly submitted that the ad-interim relief granted by this Court be confirmed.

43. Having considered the rival submissions, in my view the Defendants have failed to establish that there has been either a false or misleading statement in relation to a material

¹³2012 52 PTC 298 (DB).

particular made by the Plaintiff and hence there is no merit in the application under Order 39 Rule 4 of the Code of Civil Procedure, 1908.

44. Having so held, it would now be necessary to consider the Interim Application on merits. It is necessary to note

that the Plaintiffs Trade Marks “ELEKTROMAG” and  are registered and which registration dates back to year 1980 and that of user since September, 1973. There is material on record to show that the Plaintiffs have been using the aforementioned marks and their presence in the market has been for a significant length of time. The Plaintiffs as aforementioned have disclosed their invoices and sales figures and C.A. certificates. Further, it is relevant to consider that the Defendant No.1 was an ex-employee of the Plaintiff No.2 and thus aware of the goodwill and reputation of the Plaintiffs mark. This is a necessary factor in view of the Defendants coming up with the

impugned Trade Marks “ELEKTROMAGNETISCH” and  which incorporates the essential and dominant feature of the Plaintiff

registered Trade Mark, “ELEKTROMAG” and  apart from using the alphabet ‘K’ in “ELEKTROMAGNETISCH”. Thus, it cannot be held that there are bonafides on the part of the Defendants in adopting such a mark. Prima facie, it appears that the adoption and use of the impugned Trade Marks was an attempt to piggy back upon the goodwill and reputation of the Plaintiffs’ registered Trade Marks. Further, it is settled law that when the whole of the Plaintiffs’ mark as in the present case is subsumed in the Defendants’ mark “ELEKTROMAGNETISCH”, a case is made out for infringement. This has been held by this Court in the case *Jagdish Kamath & Ors. (Supra)*.

45. Another factor which is required to be considered is that in view of the Plaintiffs aforementioned marks having been registered, there is a strong presumption in favour of the Plaintiffs registration at the interlocutory stage. It has been held by the Full Bench in *Lupin Ltd. and Anr. Vs. Johnson and Johnson & Anr. (Supra)* that there is a very narrow window available to the Defendants to challenge registration of the Plaintiffs mark i.e. if the registration is exfacie illegal, fraudulent or shocks the conscience of

the Court. In the present case, the contention on behalf of the Defendants that the Plaintiffs have taken a part of the technology name “ELECTROMAGNETISM” i.e. “ELEKTROMAG” and started selling goods based on “ELECTROMAGNETISM” and hence cannot have a monopoly or stop others from using the entire word “ELECTROMAGNETISM” or “ELEKTROMAGNETISCH” which means nothing but “ELEKTROMAGTISM” has no merit. Defendants have themselves applied for registration of their Trade Mark “ELEKTROMAGNETISCH”, as its leading and essential feature and thus would be estopped from claiming that either the Plaintiffs Trade Mark “ELEKTROMAG” or the Defendants impugned trade mark “ELEKTROMAGNETISCH” is descriptive / common to trade and that no monopoly or exclusivity can be claimed therein. The decisions of this Court relied upon by Mr. Khandekar on behalf of the Plaintiffs in this context are apposite.

46. This Court has also considered in the exparte ad-interim order that the Plaintiffs have been able to establish that they have a long usage of the aforementioned marks and thus prima facie it can be held that the Plaintiffs have acquired distinctiveness as well as a secondary meaning as connoting and denoting to the members

of trade and public, the goods and business of the Plaintiffs' origin and of none else.

47. In comparing the rival Marks in the present case, it is relevant to note the decision of this Court in *Jagdish Gopal Kamath (Supra)* which in paragraph 18 has held as under:-

It is, I believe, too well settled to require further discussion that in comparing rival marks one must look at the mark as a whole. Persons recall marks in generalities and by an overall recollection of an impression of it. We do not distinguish marks on the basis of niggling detail: whether a device or a mark uses, for instance, one feather or leaf or two, or whether a mark uses an accented letter or an apostrophe is hardly the matter that embeds in common memory. In an infringement action, the rival mark need not be an exact replica or clone. Trivial and non-distinctive matters -- what one might describe as mere sideshows -- do not sufficiently distinguish a competing mark. (Rustom & Hornsby Ltd. Vs. Zamdara Engineering Co. AIR 1970 SC 1649 : 1950-2000 (22) PTC (Suppl) (1) 175(SC) General and overall impressions are everything. (M/s. Hiralal Prabhudas V. Ganesh Trading Co. & Ors., 1984 PTC 155 (Bom); Amritdhara Pharmacy V. Satyadeo Gupta, AIR 1963 SC 449: 1950-2000 (23) PTC (Suppl) (2) 1(SC). The test is that of a Persian of average intelligence and an imperfect memory. (Corn Products Refining Co. V. Shangrila Foods Products Ltd. AIR 1960 SC 142 : 1950-2000 (22) PTC (Suppl) (1) 13(SC). It is true that the Plaintiffs' registration is subject to a condition or limitation

vis-à-vis the word 'Madras'. Yet that would make as good as no difference, for one must look at the mark in its entirety.

48. Thus, it has been held in comparing rival marks one must look at the mark as a whole. The rival Marks will held to be deceptively similar where there is no doubt about the structural, visual or phonetic similarity between the marks. Further, it is relevant to note that persons recall marks in generalities and by an overall recollection of an impression of it. In the present case, by a comparison of the Plaintiffs mark and Defendants impugned mark, in my prima facie view, taking the rival marks as a whole, there is phonetic, visual and structural similarity between the rival marks. In fact, the whole of the Plaintiffs mark, “ELEKTROMAG” is subsumed in the Defendants mark “ELEKTROMAGNETISCH”. The letters “EM” of the Plaintiffs mark have also been used identically by the Defendants. The only disclaimer in the Plaintiffs’ EM registration is for the device of lighting. In view of the Plaintiffs having a prior registered mark, a case of infringement has been made out against the Defendants.

49. I do not accept the contention on behalf of the

Defendants that their adoption of the impugned mark is bonafide and / or that they are honest concurrent users, particularly considering that the Defendants were aware of the goodwill and reputation of the Plaintiffs mark, prior to their adoption of the impugned marks, Defendant No.1 being the ex-employee of the second Plaintiff. Thus, the contention of the Defendants that they had adopted their mark from what they describe as a world famous book namely “Das elektromagnetische Feld” prima facie cannot be accepted.

50. Further, I also do not find any merit in the contention of the Defendants that in view of the Plaintiffs having a registered descriptive word of technology, they cannot claim monopoly over the word. The decisions of the Supreme Court in ***J.R. Kapoor (Supra)*** and ***Shelke Beverages (Supra)*** can clearly be distinguished on the facts of those cases. In those cases, there was a finding that upon comparison of the rival marks as a whole, they were neither identical nor deceptively similar to one another. Further, this Court in ***Natco Pharma Ltd. (Supra)*** has considered aforementioned decisions of the Supreme Court and upon comparison of the rival marks in that case, although the marks used the term “OSTO”, which was considered to be with reference to the

condition “Ostoporosis”, the mark “OSTONATE” being the registered Trade Mark of the Plaintiffs was found to be deceptively similar to the Defendants’ mark “OSTONAT”.

51. In view of my prima facie finding that the rival marks are not only phonetically, visually and structurally similar but the whole of the Plaintiffs mark is subsumed in the Defendants mark, a case of infringement is made out. Accordingly, the exparte ad-interim order dated 16th January, 2023 is confirmed and the Interim Application is made absolute in terms of prayer Clauses (a) and (b) of the Interim Application which read as under:-

(a) that pending the hearing and final disposal of the suit, the Defendants by themselves, their proprietor, partners, directors, servants, agents, employees, stockists, distributors, dealers and all persons claiming through them be restrained by an order and temporary injunction of this Hon'ble Court from infringing the 1st Plaintiff's registered trade mark “ELEKTROMAG” bearing Registration No. 370060 in Class 09 by using the first impugned trade mark “ELEKTRO Magnetisch” and/or the impugned website/ domain name www.elektromagnetisch.com and/or any other trade mark and/or website/ domain name containing the word “ELEKTROMAG” and/or any other word deceptively similar thereto and/or any other trade mark and/or website/

domain name identical with or deceptively similar to the 1st Plaintiff's registered trade mark "ELEKTROMAG" bearing Registration No. 370060 in Class 09 upon and in relation to lifting magnets, magnetic separator, vibrating furnace charger, vibrating feeders and/or any other goods identical with or similar to the goods covered by the 1st Plaintiff's aforesaid registration or in any other manner whatsoever;

(b) that pending the hearing and final disposal of the suit, the Defendants by themselves, their proprietor, partners, directors, servants, agents, employees, stockists, distributors, dealers and all persons claiming through them be restrained by an order and temporary injunction of this Hon'ble Court from infringing the 1st Plaintiff's

registered trade mark " bearing Registration No. 370061 in Class 09 by using

the second impugned trade mark " and/or any other trade mark identical with or deceptively similar to the 1st Plaintiff's

registered trade mark " bearing Registration No. 370061 in Class 09 upon and in relation to lifting magnets, magnetic separator, vibrating furnace charger, vibrating feeders and/or any other goods identical with or similar to the goods covered by the 1st Plaintiff's aforesaid registration or in any other manner whatsoever;

52. In view of the above findings and considering that the Leave Petition filed under Clause XIV of the Letters Patent Act has been made absolute in terms of prayer Clause (a), in addition to

prayer Clauses (a) and (b) of the Interim Application, there shall be interim relief in terms of prayer Clauses (c) and (d) of the Interim Application, which read thus:-

(c) that pending the hearing and final disposal of the suit, the Defendants by themselves, their proprietor, partners, directors, servants, agents, employees, stockists, distributors, dealers and all persons claiming through them be restrained by an order and temporary injunction of this Hon'ble Court from infringing the 1st Plaintiff's registered trade mark bearing Registration No. 370060 in Class 09 by using the impugned trading names and styles



“ELEKTRO Magnetisch” and “” and/or any other trading name and style identical with or deceptively similar to the 1st Plaintiff's registered trade mark No. 370060 in Class 09 for offering, exposing and/or stocking for sale and/or putting in market lifting magnets, magnetic separator, vibrating furnace charger, vibrating feeders and/or like goods and/or on business papers including but not limited to visiting cards and/or in advertising pertaining to sale of lifting magnets, magnetic separator, vibrating furnace charger, vibrating feeders and/or the like goods or in any other manner whatsoever;

(d) that pending the hearing and final disposal of the suit, the Defendants by themselves, their proprietor, partners, directors, servants, agents, employees, stockists, distributors, dealers and all persons claiming through them be restrained by an order and temporary injunction of this Hon'ble Court from manufacturing, marketing, selling, exhibiting for sale, distributing, keeping in possession, advertising, trading and/or otherwise dealing in lifting magnets, magnetic separator, vibrating furnace charger, vibrating feeders and/or similar goods under the first impugned trade mark "ELEKTRO Magnetisch" and/or the impugned website/domain name www.elektromagnetisch.com and/or any other trade mark and/or website/domain name containing the 1st Plaintiff's well-known trade mark "ELEKTROMAG" and/or any other trade mark identical with or deceptively similar to the 1st Plaintiff's said well-known trade mark "ELEKTROMAG"; and/or under the second impugned trade mark  and/or any other trade mark identical with or deceptively similar to the 1st

Plaintiff's well-known trade mark ; and/or from running the business of manufacturing, marketing, selling, exhibiting for sale, distributing, keeping in possession, advertising, trading and/or otherwise dealing in lifting magnets, magnetic separator, vibrating furnace charger, vibrating feeders and/or similar goods under the impugned

trading names and styles “ELEKTRO



Magnetisch” and “ELEKTRO Magnetisch” and/or any other trading name/ style containing the trade mark “ELEKTROMAG” and/or any other trade mark deceptively similar thereto and/or any other trading name and style identical with or deceptively similar to the 1st Plaintiff’s said well-known trade mark “ELEKTROMAG”, so as to pass off or enable others to pass off the Defendants’ goods and/or business as and for the Plaintiffs’ said well-known goods and/or business or in any other manner whatsoever;

53. The, Interim Application is accordingly disposed of. There shall be no order as to costs.

[R.I. CHAGLA J.]